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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/702,093	10/30/2000	Alison Salyer Bagwell	15260	7880

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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 02/13/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

09/702,093

Applicant(s)

BAGWELL ET AL

Examiner

Judy M. Reddick

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10/26/01; 2/20/01; 10/30/00; 10/10/01.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 14-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-53 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 & 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. ***Restriction to one of the following inventions is required under 35 U.S.C. 121:***
  - I. ***Claims 1-13, drawn to a carbonate-based composition, classified in class 524, subclass 211.***
  - II. ***Claims 14-26, drawn to a sulfate-based composition, classified in class 524, subclass 156.***
  - III. ***Claims 27-40 and 52-53, drawn to a method using carbonate ingredients, classified in class 427, subclass 261.***
  - IV. ***Claims 41-51, drawn to a method using a sulfate ingredient, classified in class 427, subclass 261.***

***The inventions are distinct, each from the other because of the following reasons:***

2. ***Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product, as claimed, can be used in an entirely different process such as for flame reduction; a matrix for biocides/fungicides, etc.***

3. ***Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in a materially different process such as for flame reduction; a matrix for biocides/fungicides, etc..***

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4. *Inventions I and II are separate and distinct, each from the other as per being related as mutually exclusive species, each not requiring the particulars of the other for patentability. Note that the Group I invention does not require a sulfate ingredient as does the Group II invention. By the same token, the Group II invention does not require a carbonate ingredient as does the Group I invention. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.*

5. *Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.*

6. *During a telephone conversation with Mr. Steven Flack on 01/10/02 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-53 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.*

7. *Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).*

#### **DETAILED ACTION**

#### **Claim Rejections - 35 USC § 112**

8. *The following is a quotation of the second paragraph of 35 U.S.C. 112:*

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

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9. *Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

10. *Claim recited rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

A) *The recited "polymer or copolymer" per claims 1 and 2 constitutes indefinite subject matter as per said components overlap in scope. If applicants intend a homopolymer then use of such in lieu of "polymer" is suggested.*

B) *The recited "selected from sodium bicarbonate, sodium carbonate or combinations thereof" per claim 1 constitutes indefinite subject matter as per a) the use of improper Markush terminology, use of "selected from the group consisting of" is proper; b) it is not clear as to how "sodium bicarbonate" and "sodium carbonate" differentiate over one another.*

C) *The recited "between about 5 to 95 %" per claim 2, "between about 5 to 20 %" per claim 3, "between about 0 to 80 %" per claim 5 constitute indefinite subject matter as per a) "to" is inconsistent with "between" and b) the "wt." entity is missing.*

D) *In claims 6, 7, 9, 11 and 12, "wt." should be inserted before the "%" symbol so as to engender claim language clarity.*

E) *The recited "selected from the group including" per claim 8 constitutes indefinite subject matter as per the use of improper Markush language, use of "selected from the group consisting of" is proper and is suggested.*

F) *The recited "sodium bicarbonate" and "sodium carbonate" per claims 10 and 11 constitute indefinite subject matter as per reasons set forth in item B) supra.*

**Information Disclosure Statement**

11. *The information disclosure statements filed 01/26/01 and 10/10/01 have been considered and placed in the application file.*

**All allowable Subject Matter**

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12. *Claims 1-13(elected embodiment) are deemed allowable over the prior art of record as per one having ordinary skill in the art would not have been endowed with any reasonable motivation to extrapolate the precisely defined sodium carbonate/urea-governed aqueous coating formulation, as claimed, from any of the prior art of record with any reasonable expectation of success. Too much picking and choosing, mixing and matching would be involved and highly unwarranted. Claims 1-13 would be allowed if rewritten, amended and/or satisfactorily rebutted so as to overcome the 112 issues set forth supra.*

**Conclusion**

13. *The prior art made of record and not relied upon is considered illustrative of the general state of the art.*

*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..*

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.*

*Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.*

*J. M. Reddick*  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR *JMR*  
February 11, 2002